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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/835,887	04/16/2001	Paola Lenti	1011-287	4551

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EXAMINER

PIERCE, JEREMY R

ART UNIT	PAPER NUMBER
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1771

DATE MAILED: 04/07/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/835,887

Applicant(s)

LENTI, PAOLA

Examiner

Jeremy R. Pierce

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 10 March 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 29-31 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 29-31 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on January 14, 2005 has been entered.

### ***Response to Amendment***

2. Applicant's amendment filed on January 14, 2005 has been entered. Claims 24-28 have been cancelled. New claims 29-31 have been added. Claims 29-31 are currently pending.

### ***Claim Objections***

3. Claim 30 is objected to because of the following informalities: Claim 30 depends from claim 20, which has previously been cancelled. The Examiner will assume that claim 30 depends from claim 29 instead. Appropriate correction is required.

### ***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

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The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 29 and 30 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 29 recites "a central layer having a top face on which a woven or non-woven material top layer is arranged, said top layer having a top surface comprising a woven and dyed wool felt having smear resistant properties." This is indefinite because the top layer is recited as being woven or non-woven, and then later recited as being woven and dyed wool felt. Is Applicant saying that the top layer is a non-woven cloth that further comprises woven and dyed wool felt on the surface? If so, is this supported by the specification?

### ***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 29-31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bender et al. (U.S. Patent No. 4,263,727) in view of Latzke (U.S. Patent No. 4,887,368) and Dessaint et al. (U.S. Patent No. 4,295,976), and further in view of Cohen (U.S. Patent No. 4,187,621).

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Bender et al. disclose a web of natural or synthetic fibers that is flame-laminated to closed-cell polyolefin foam (column 1, lines 31-35) without the use of adhesive (column 2, lines 31-33). In a preferred embodiment, closed-cell polyethylene foam is combined with an upper layer of woven cotton fabric and a lower layer of nonwoven nylon (column 2, lines 62-68). The nonwoven nylon fabric layer in the laminate would be suitable for attachment to a male coupling portion of a tearable strip means because nonwoven fabric is capable of coupling to male portions of tearable strip means.

Although Bender et al. disclose the top layer can be a woven cotton fabric (column 2, line 65), the reference does not disclose it to be a woven wool fabric that is dyed and smear resistant. Latzke discloses that woven wool, as well as woven cotton can be used as a skin compatible layer in a shoe insole (column 7, lines 42-46). It would have been obvious to one having ordinary skill in the art to use woven wool as the top layer in the insole of Bender et al., since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use. *In re Leshin*, 125 USPQ 416. It would also have been obvious to dye the wool fabric any desired color for use as a shoe insole. Neither Latzke nor Bender et al. disclose a smear resistant property in the upper layer. Dessaint et al. disclose that a stain resistant property may be imparted onto textile fabrics, including woven and nonwoven articles of cotton and wool (column 7, lines 36-45). It would have been obvious to one having ordinary skill in the art to add a stain-resistant agent to the top layer of Bender et al. in order to improve likelihood of avoiding stains, as taught by Dessaint et al.

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Although Bender et al. does not disclose the top layer to have projecting and recessed patterns, Latzke shows that the insole material is preferably made with recessed areas to better accommodate a foot (see Figures 15 and 16). It would have been obvious to a person having ordinary skill in the art at the time of the invention to provide the insole of Bender et al. with recessed areas in order to make the insole more comfortable for the wearer. Bender et al. do not disclose that the shoe insole is die cut with a contour mold. Cohen teaches an insole for shoes where the layers are flame-bonded together and then cut and conformed in contour with various thickness (Claim 1), so Cohen also recognizes the importance of molding with recessed areas and projected areas. It would have been obvious to one having ordinary skill in the art to use the method of forming a shoe insole disclosed by Cohen in the insole of Bender et al. in order to create a shoe insole that better fits the wearer's foot.

### ***Response to Arguments***

8. Applicant's arguments filed January 14, 2005 have been fully considered but they are not persuasive.

9. Applicant argues that Bender is not concerned with anti-smear surfaces and provides no guidance as to how to provide a surface with anti-smear properties. In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

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10. Applicant argues that the insole art is not analogous to the art of the present invention. However, Applicant's claims are directed to a laminate comprising layers. The references are all laminate materials comprising layers as well. The recitation that the modular coating elements are designed for coating floors and walls is only a recitation of an intended use. A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 370 F.2d 576, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 312 F.2d 937, 939, 136 USPQ 458, 459 (CCPA 1963).

Furthermore, the insole art is pertinent to the problem of the present invention. On page 3 of the Specification, Applicant states that one of the objects of the present invention is to provide "comfortable massaging effect to the user foot bottom." This is an object that is accomplished in the insole art. Finally, Applicant states that the insole art is not analogous to the art of making anti-smear surfaces. However, providing stain resistance to fabric layers is well known, and a method for doing so is provided by Dessaint et al.

11. Applicant argues that Bender specifically states that it is not necessary to provide anti-staining treatment to his sheet material, citing Bender at column 2, lines 29 to 36. However, Bender is teaching that the adverse staining that comes from using adhesives is avoided. This does not teach away from using an anti-staining agent on the surface

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fabric. The surface of the insole will become stained through use and interaction with a wearer's foot, even if there isn't any adhesive used to bond the insole. Bender teaches that staining is an adverse condition; so adding an anti-staining agent would be obvious to a person of ordinary skill in the art.

12. Applicant argues that Bender, through his overall disclosure, considers his material very comfortable for accommodating a foot; thus, one would not provide projections or recesses as taught by Latzke. However, nothing in Bender teaches away from a modification that would better accommodate a wearer's foot.

13. Applicant argues that Latzke suggests the outer top surface of his sole material to be texturized by forming wedge or trapezoidal projections which project exclusively from the top surface of the sole material. However, the entire insole of Latzke is shown to have projecting and recessed patterns. For example, in Figure 16, the sides of the insole are shown to be projecting while the center section of the insole is shown to be recessed. While the series of bumps found on the surface of the shoe insole may only be derived from the top layer, the structure as a whole is created with projections and recessions because it is not planar. Projections and recessions exist when the insole has a contoured shape. Latzke contains such a contoured shape.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeremy R. Pierce whose telephone number is (571)



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272-1479. The examiner can normally be reached on Monday-Friday between 9am and 5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris can be reached on (571) 272-1478. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JRP

Jeremy R. Pierce  
April 4, 2005

*Eligible M/Gle*  
2005-04-04